

**REMARKS**

Claims 1-70 are pending in the application.

Claims 1-70 have been rejected.

I. **REJECTIONS UNDER 35 U.S.C. § 103**

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Monot (U.S. Patent No. 5,708,778) in view of Li (U.S. Patent No. 6,012,088). Claims 1-6, 15-120, 30-34, 43-48 and 57-62 were rejected under 35 U.S.C. § 103(a) as being upatentable over Hansen (U.S. Patent No. 5,838,907) in view of Li. Claims 7-14, 21-29, 35-42, 49-56 and 63-70 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hansen in view of Li, and further in view of Ekstrom (U.S. Patent No. 5,968,126). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007))).

**Claim 1:**

With respect to the rejection of independent Claim 1, this claim recites determination within a first network device of configuration attributes for operably connecting the first network device to a subnet based on configuration information for the subnet, and configuring the first network device for operable connection to the subnet according to the configuration attributes. Such a feature is not found within the cited references, taken alone or in combination. Monot teaches automatically selecting communication parameters for data terminal equipment (DTE) within a network, such as packet size, format, etc., in which the parameters for the terminal are determined by iteratively probing the network's carrier equipment starting with an initial set of parameters and utilizing any probe responses until the parameter set is narrowed to a set of correct parameters:

The DTE executes an automatic configuration program for performing the method. A probe structured with respect to a particular configuration parameter, such as packet size, format, and so forth. The probe is a function of the protocol parameter being configured, selected previous probes for that parameters, and selected answers to the previous probes that the DCE provided in response thereto. The DCE receives the probe and responds with an answer. The automatic configuration program

determines from the probe, the answer, selected ones of the prior probes, and selected ones of the prior answers whether a value that correctly configures the parameter may be established. If not, another probe is created based on the parameter value of the probe, the prior probes, the answer, and the prior answers. This cycle is repeated until the parameter value is established, or it is determined that the parameter value cannot be established. The DTE then configures the next parameter in the same iterative manner.

Monot, Col. 2, lines 44-62. However the system disclosed in Monot uses one probe (or set of probes) for each parameter to “iteratively restrict” the current set of potential parameter values until a correct value can be determined from the current set of potential values. Monot, Col. 2, lines 12-13 and 30-34. Thus, Monot does not teach detecting configuration, merely selecting from among a known range of parameter values.

In addition, the probe does not involve detecting configuration information for the network, only parameter values for a communications protocol. The Office Action concedes Monet fails to disclose configuration attributes for operably connecting the first network device to a subnet based on configuration information for the subnet detected by the first network device, and relies on Li as teaching such a feature. Office Action, page 3. Li describes an “automatic configuration” process in which a device automatically connects itself to an appropriate location on the Internet and to download a configuration information. Li, Col. 9, lines 15-16. With the exception of certain identification information provided by the user (e.g., a desired domain name), all of the configuration information to configure the Li Internet access device is stored in a database in an Internet Service Provider (ISP). Li, Figure 11b, steps 724 and 726, Figure 12, Col. 9, lines 52-53. Thus, the Li system simply calls up the ISP and downloads the configuration information. Nothing in Li teaches or suggests having the Internet access device search the network to detect configuration attributes in the manner recited in Claim 1.

The Office Action proposes combining the respective teachings of Monot and Li “to be able to configure the existing infrastructure of the Network in order to retrieve configuration data from any location.” Office Action, page 3. However, the teachings of the references cited do not support the conclusion that such a result would be obtained by the combination proposed. Li teaches

retrieval of configuration information from a single, predefined location; Monot teaches testing predefined ranges of parameters. Neither reference suggests that configuration data might be retrieved from any location.

In addition, the references do not support a reasonable expectation of success in combining the references as proposed to achieve the claimed invention. The two references are directed at different problems (selecting parameters for a communications protocol versus IP address configuration), such that successful combination is not apparent. In particular, there is no suggestion in the references that the “probes” (packets, messages, frames, datagrams) employed in Monot are suitable for determining the same types of configuration information (domain name, IP address block) contained within the configuration file in Li.

**Claims 1-6, 15-20, 30-34, 43-48 and 57-62:**

Independent claims 1, 15, 29, 43, and 57 each recite determination within a first network device of configuration attributes for operably connecting the first network device to a subnet based on configuration information for the subnet, and configuring the first network device for operable connection to the subnet according to the configuration attributes. Such a feature is not found within the cited references, taken alone or in combination. Hansen describes “a configuration manager for configuring a network device remotely coupled thereto . . .” Hansen, Abstract (emphasis added). In the system disclosed by Hansen, a network device configuration tool 10 is located within a remote computer system 2 rather than within a network device 26 being configured, and constructs a configuration file suitable for export from computer 2 to network device 26. Hansen, Col. 4, lines 65-67. The configuration file (with configuration information) is then sent by the computer system 2 to the remotely located network device 26. Hansen, Col. 5, lines 22-26. Accordingly, Hansen does not teach “the use of a configuration determination module of the first network device for determining configuration attributes for operably connecting the first network device to the subnet.” Hansen does not teach a configuration determination module—and specifically does not teach an autoconfiguration module--within the first network device.

In addition, Hansen only teaches a guided configuration process employing requests to the network administrator for configuration information. Hansen teaches the use of a configuration guide 18 within computer 2 to collect information necessary to configure the network device by engaging the network administrator in a dialog during which the configuration guide 18 generates a series of graphical user interfaces (GUIs). Each GUI displays a request for information and provides areas in which the requested information may be inputted and buttons for guiding the network administrator through the dialog. Hansen, Col. 14, lines 23-29. Hansen does not teach or suggest detecting configuration information for a subnet by a network device to determine configuration attributes for operably connecting the network device to the subnet.

The Office Action concedes that Hansen does not disclose configuring the first network device with an auto configuration module, but asserts that Li teaches automatic configuration according to configuration information downloaded to the device. Office Action, page 4. However, Li does not cure the defect of Hansen in failing to describe detection of configuration attributes by the device being configured as recited in the claims. Accordingly, the combination fails to disclose at least one limitation of the claims.

In addition, Claims 5, 19, 33, 47 and 61 each recite that the configuration attributes comprise an IP subnet mask that is determined based on configuration information unique to the subnet and derived from passively listening to router control traffic. Such a feature is not found in the cited references. Neither Hansen nor Li teach determination of subnet masks, nor deriving such a mask by passively listening to traffic. Claims 7, 21, 35, 49 and 63 each recite that the configuration attributes comprise virtual local area network (VLAN) information including tag identifications, types, protocols, addresses, and port-to-VLAN mappings. Such a feature is not found in either Hansen or Li.

**Claims 7-14, 21-29, 35-42, 49-56 and 63-70:**

These claims depend from the independent Claims, and for the same or similar reasons set forth above with respect to rejection of the independent Claims, the combination of Monot-Li and Hansen-Li fails to disclose, teach or suggest every element in the independent Claims. Since the

Office does not indicate or point to any portion(s) of Ekstrom that teach any element recited in the independent Claims, Ekstrom does not cure the noted deficiencies in Monot, Hansen, and Li (as amply described above). For this reason alone, the rejection of Claims 7-14, 21-29, 35-42, 49-56 and 63-70 should be withdrawn.

In addition, Ekstrom is directed to forwarding messages from a station to other stations in a virtual broadcast domain (VBD) (which can be a VLAN). Membership in the VBD is determined based on the user who logged onto the station. Upon power up, the station belongs to a default VBD, and when the user logs on, the station is switched from the default VBD to the VBD assigned to the user. Ekstrom, Abstract. Nothing in Ekstrom discloses or even hints at the concept of having (1) the network device search the network for “configuration attributes” in the manner disclosed by the Applicant or (2) having the network device configure itself with an “autoconfiguration module” in the manner disclosed by the Applicant. Regarding Claims 7, 21, 35, 49 and 63, though Ekstrom may refer to VLAN information, it appears that the device is already connected to the network, and the messages transmitted merely include a VLAN ID tag which identifies the VLAN in which the message will be forwarded. This teaching does not appear related to configuring a first network device for connection to a subnet based on subnet information detected by the first network device.

In addition, regarding Claims 9, 23, 37, 51, 65; Claims 12, 26, 40, 54, 68; Claims 13, 27, 29, 41, 55, 69; and Claims 14, 28, 42, 56, 70 – all rejections based on Hansen-Li-Ekstrom – the Office Action points to portions of either Hansen or Li as teaching the element(s) recited in these claims. Thus, Applicant is confused as to what element(s) in Ekstrom teach these element(s). It appears that the rejection of these claims is based on Hansen-Li (without Ekstrom). If so, Applicant reiterates its arguments set forth above regarding the Hansen-Li rejections and the deficiencies noted therein.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejections of Claims 1-70.

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

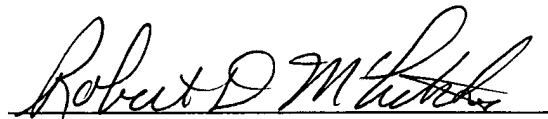
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@munckcarter.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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